

REMARKS

Claims 6, 8 and 12-18 remain rejected under 35 U.S.C. §101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well-established utility.

Previously, Applicants pointed out that the claimed subject matter can readily be used as a tissue marker. In response, the Examiner states such is not a substantial or specific utility. While the Examiner acknowledges the asserted utility for identifying genetic disorders is credible, the Office Action further alleges such too is not specific or substantial, and would also require undue experimentation. Forgetting for the moment whether the level of experimentation is, in fact, undue, it is unclear to Applicants why such admittedly credible utility is not substantial. Rather, it clearly is. Identifying a genetic disorder is plainly more than some *de minimus* utility like mere use as ballast, or fuel. Similarly, it is not seen why such admittedly credible utility is not specific. Indeed, such utility is necessarily specific to the claimed sequences. Accordingly, clarification is required.

In any event, it is seen that the present invention is a full-length (2033 BP with an open reading frame of 1053 BP) clone that encodes a 350 amino acid Type I transmembrane protein isolated from human epidermoid carcinoma KB cell line.

It is plain that assaying humans for this sequence, which is not found in normal cells, can identify both the existence of a disease state and the expectation of such disease state. Moreover, it is similarly clear that such determination is simple and can, in fact, be readily automated. Additionally, such use is obviously specific to the claimed subject matter.

Accordingly, respectfully submitted, the rejection under 35 U.S.C. § 101 is overcome and withdrawal thereof is earnestly solicited.


Claims 6, 8 and 12-18 are also rejected under 35 U.S.C. §112 first paragraph. In support of this rejection, the Examiner states that because the invention is not supported by a substantial asserted utility, one of ordinary skill would not know how to use it. However, as seen explained above, the present invention is supported by a specific and substantial utility. Moreover, there is no basis in fact for alleging that determination of the claimed sequence in a human would require any experimentation, let alone undue experimentation.

In view of the above remarks, Applicants submit that all of the Examiner's concerns are now overcome and the claims are now in allowable condition. Accordingly, reconsideration and allowance of this application is earnestly solicited.

Claims 6, 8 and 12-18 remain presented for continued prosecution.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



Attorney for Applicants
Lawrence S. Perry
Registration No. 31,865

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 287656v1